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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/775,793	02/05/2001	Jeffrey L. Dalton	174-880	7604

20582 7590 01/21/2004

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EXAMINER	
BUTTNER, DAVID J	

ART UNIT	PAPER NUMBER
1712	

DATE MAILED: 01/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/775,793	DALTON ET AL.	
	Examiner	Art Unit	
	David Buttner	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-44* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-44* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Claims 1-29 are not supported by the parent application as they lack "resilience index" and "<7.5% unreacted isocyanate groups ". The cis to trans catalysts of claims 42 – 44 are also unsupported by the parents. The effective filing date for these claims is 2/5/01.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16,17,19, 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is no basis for "inner cover" in claims 16 and 17

There is no basis for "the mooney" in claim 19.

There is no basis for "castable" in claim 34.

Claim 29 is rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. A "wound" hoop stress layer critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). It appears the specification only teaches "wound" hoop stress layers (page 12 line 9; page 34 line17). The claim is broader than the enabling disclosure as windings are not required.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1,2,3,4-6, 8-15, 18-22 and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Sano '679 patent in view of Dewanjee '268.

Sano exemplifies wound golf balls having a center of Neocis BR 60. This appears to be one of applicant's preferred polybutadienes (table 1 page 18 of spec). the cover can be polyurethane (col. 6 line 50). Details of the polyurethane are not given.

It is known in the art that polyurethanes are typically made by reacting a prepolymer with a polamine a polyol (col. 2 line 27-29 of Dewanjee). Also, Dewanjee teaches the typical –NCO content of such prepolymers (col. line 63).

It would have been obvious to form Sano's urethane cover using conventional procedures known in the golf ball art. Only the expected results are achieved.

Claims 30-32 and 41 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Maruko '699 patent.

Maruko exemplifies wound golf balls having a dual cover. The inner cover is harder than the other.

Claims 30-34 and 41 rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Maruko '096 patent.

Maruko exemplifies wound golf balls having a dual cover. The inner cover is harder than the other. The outer cover can be polyurethane (col. 3 line 10).

Claims 30-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Maruko '096 Patent in view of Dusbiber '061 or Isaac '568

Maruko suggest urethane covers, but does not go into detail about urethane production.

Producing urethane golf ball covers through reacting polyds or diamines with a prepolymer is well known. Isaac (abstract) and Dusbiber (abstract) both teach such techniques.

It would have been obvious to produce Maruko's polyurethane cover in the conventional manner. Only the expected results are obtained.

Claims 42- 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Maruko '096 or '699 Patents in view of WO 00/38794.

Maruko does not suggest cis to trans catalysts in his centers.

The inclusion of cis to trans catalysts are known produce softer, faster balls (see abstract of WO 00/38794). Note that WO 00/38794 teach the cis to trans catalyst are useful in wound balls (page 25 line 36) and urethane covered balls (page 22 line 27).

It would have been obvious to include a cis to trans catalyst in the centers of Maruko for the expected improvements.

Claims 1-28 and 30-44 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Wu '261 patent.

Wo (abstract) suggests golf balls of the same center and cover as applicants' claims.

Ball can be wound (col. 11 line 35).

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-28 and 30-44 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-50 of U.S. Patent No. 6486261. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims mirror those of the patent with the additional requirement of a wound layer. It is clear that the "outer core layer" of claim 29 of the patent can be a wound layer (col. line 35).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is 571 272 1084. The examiner can normally be reached on Weekdays from 10:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571 272 1119. The fax phone

number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

DAVID J. BUTTNER
PRIMARY EXAMINER

D. Buttner
January 13, 2004